



JPW  
Dkt. 78805/JPW/AJC

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicants : Ehud Cohen, et al.

Serial No. : 10/722,589 Examiner : Mark W. Bockelman

Filing Date : November 25, 2003 Art Unit : 3766

For : TREATMENT OF DISORDERS BY UNIDIRECTIONAL NERVE STIMULATION

30 Rockefeller Plaza, 20<sup>th</sup> Floor  
New York, New York 10112  
January 7, 2010

Mail Stop Amendment  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

COMMUNICATION RESUBMITTING A COMMUNICATION FILED DECEMBER 18,  
2009 WITH TYPOGRAPHICAL ERROR IN SERIAL NUMBER

Applicants attach as an **Exhibit A** hereto a copy of a Communication in Response to August 19, 2009 Office Action and Petition for Two-Month Extension of Time filed by mail on December 18, 2009 in connection with the above-identified application.

The first page of the attached Communication mistakenly identifies the U.S. Serial Number as 10/722,586, rather than 10/722,589. Please associate the attached Communication with U.S. Serial Number 10/722,589.

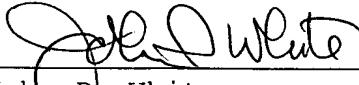
If a telephone interview would be of assistance in advancing prosecution of the subject application, applicants' undersigned attorney invites the Examiner to telephone him at the number provided below.

No fee is deemed necessary in connection with the filing of

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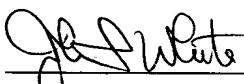
this Communication. However, if any fee is required, authorization is hereby given to charge the amount of such fee to Deposit Account No. 03-3125.

Respectfully submitted,

  
John P. White  
Registration No. 28,678  
Attorney for Applicants  
Cooper & Dunham LLP  
30 Rockefeller Plaza  
New York, New York 10112  
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I hereby certify that this correspondence is being deposited this date with the U.S. Postal Service with sufficient postage as first class mail in an envelope addressed to:

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 11/11/0

John P. White Date  
Reg. No. 28,678

# **EXHIBIT A**



Dkt. 78805/JPW/AJC

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicants : Ehud Cohen, et al.

Serial No. : 10/722,586 Examiner : Mark W. Bockelman

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For : TREATMENT OF DISORDERS BY UNIDIRECTIONAL NERVE STIMULATION

30 Rockefeller Plaza, 20<sup>th</sup> Floor  
New York, New York 10112  
December 18, 2009

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COMMUNICATION IN RESPONSE TO AUGUST 19, 2009 OFFICE ACTION AND  
PETITION FOR A TWO-MONTH EXTENSION OF TIME

This Communication is submitted in response to the August 19, 2009 Office Action issued by the United States Patent and Trademark Office in connection with the above-identified application. The August 19, 2009 Office Action set a shortened statutory period of one (1) month to reply. Therefore, a response to the August 19, 2009 Office Action was due October 19, 2009. Applicants hereby petition for a two-month extension of time to respond. The fee for a two-month extension of time is TWO HUNDRED AND FORTY FIVE DOLLARS (\$245.00) and a check in this amount is enclosed. With a two-month extension of time a response is now due December 19, 2009. Accordingly, this response is being timely filed.

**Remarks** begin on page 2 of this paper.

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Exhibit A

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Remarks

Restriction Requirement Under 35 U.S.C. §121

In the August 19, 2009 Office Action the Examiner required election of one of the two following allegedly patentable distinct inventions:

- I. Claims 35-43, 52-53, 56-57, 60, 63-64, 68-70, 73, 79-81, 84-95, 97-98, 100-102, and 108-109 drawn to a device for treating nerve tissue, classified in class 607, subclass 116.
- II. Claims 111-113, and 116-117, drawn to a method of treating nerve tissue, classified in class 607, subclass 45.

The Examiner stated that inventions I and II are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product. The Examiner stated that in the instant case, the method does not require a plurality of electrodes or an implantable controller.

The Examiner therefore concluded that restriction for examination purposes is proper because these inventions are independent and distinct for the reasons given above and there would be a serious search and examination burden if

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restriction were not required because one or more of the following reasons apply: (a) the inventions have acquired a separate status in the art in view of their different classification; (b) the inventions have acquired a separate status in the art due to their recognized divergent subject matter; (c) the inventions require a different field of search (for example, searching different classes/subclasses or electronic resources, or employing different search queries); (d) the prior art applicable to one invention would not likely be applicable to another invention; or (e) the inventions are likely to raise different non-prior art issues under 35 U.S.C. §101 and/or 35 U.S.C. §112 first paragraph.

The Examiner has required restriction between product and process claims. Where applicant elects claims directed to the product, and the product claims are subsequently found allowable, withdrawn process claims that depend from or otherwise require all the limitations of the allowable product claim will be considered for rejoinder. All claims directed to a nonelected process invention must require all the limitations of an allowable product claim for that process invention to be rejoined. In the event of rejoinder, the requirement for restriction between the product claims and the rejoined process claims will be withdrawn, and the rejoined process claims will be fully examined for patentability in accordance with 37 C.F.R. §1.104.

Applicants' Response:

In response, applicants hereby elect Invention I, which includes claims 35-43, 52-53, 56-57, 60, 63-64, 68-70, 73, 79-

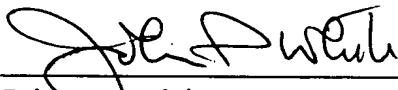
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81, 84-95, 97-98, 100-102, and 108-109 drawn to a device for treating nerve tissue. This election is made without traverse.

If a telephone interview would be of assistance in advancing prosecution of the subject application, applicants' undersigned attorney invites the Examiner to telephone him at the number provided below.

No fee, other than the enclosed \$245.00 fee for a two-month extension of time, is deemed necessary in connection with the filing of this Communication. However, if any fee is required, authorization is hereby given to charge the amount of such fee to Deposit Account No. 03-3125.

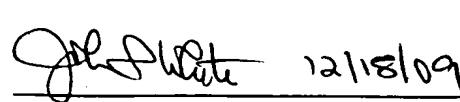
Respectfully submitted,



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 12/18/09  
John P. White Date  
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